

RECEIVED
CENTRAL FAX CENTER

NOV 27 2006

REMARKS

Claims 1-4, 8-11, 15-17, and 21-24, all the claims pending in the application, stand rejected on prior art grounds. Applicants respectfully traverse these rejections based on the following discussion.

I. The Prior Art Rejections

Claims 1-2, 4, 8-9, 11, 15-16, 21-22, and 24 stand rejected under 35 U.S.C. 102(a) as being anticipated by Palpanas et al. (NPL "Incremental Maintenance for Non-Distributive Aggregate Functions", Proceedings of the 28th VLDB Conference, Hong Kong, China, 2002), also referred to herein as Palpanas. Claims 3, 10, 17, and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Palpanas, in view of Liu et al. (NPL "Derivation of Incremental Equations for Nested Relations", Database Conference, 2001, ADC 2001, Proceedings 12th Australasian, pp. 76-82), hereinafter referred to as Liu. Applicants respectfully traverse these rejections based on the following discussion.

The Office Action asserts that the request for change of inventorship is defective because "an amendment cannot remove an inventor from an application" (Office Action, p. 2, para. 2). In support for this contention, the Office Action cites MPEP 201.03 and 37 CFR 1.48(b) (Office Action, p.2, para. 2).

Applicants would like to point out that the very first line following the title of MPEP 201.03 states that "[c]orrection of inventorship in an application is permitted by amendment under 35 U.S.C. 116". Moreover, 35 U.S.C. 116 provides that "[w]henver through error a person is named in an application for patent as the inventor ... and such

10/643,644

7

error arose without any deceptive intention on his part, the Director may permit the application to be *amended* accordingly, under such terms as he prescribes" (emphasis added).

In regards to 37 CFR 1.48(b), Applicants would first like to note that the title of this subsection is "Nonprovisional application-fewer inventors due to *amendment* or cancellation of claims" (emphasis added). Further, Applicants emphasize that the very first line following the title of 37 CFR 1.48(b) provides that "[i]f the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an *amendment* must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed."

Accordingly, the legal authority cited by the Office Action clearly provides that an inventor can be removed from an application via an amendment.

Additionally, MPEP 201.03 (III) states that "[a]mendment of the inventorship requires: (1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and (2) The processing fee" (emphasis added). § 1.33(b) provides that "[a]mendments and other papers ... filed in the application must be signed by: (1) A registered patent attorney or patent agent of record appointed in compliance

with § 1.32(b); [or] (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34". § 1.34 provides that "[w]hen a registered patent attorney or patent agent acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the registered patent attorney or patent agent must specify his or her registration number and name with his or her signature."

First of all, Applicants' Amendment filed on June 27, 2006 was signed filed by a registered patent attorney (Duane N. Moore, Esq., Registration No. 533525) authorized to represent the particular party in whose behalf he acts (Assignee International Business Machines Corporation). Moreover, Applicants' Amendment filed on June 27, 2006 requested correction of inventorship to identify the named inventors being deleted and acknowledged that the inventor's invention is no longer being claimed in the nonprovisional application. Specifically, page 10 paragraph 2 of Applicants' Amendment filed on June 27, 2006 provided that:

Songting Chen is a joint inventor of the invention defined by claims 5-7, 12-14, 18-20, and 25-27, which are cancelled above, of the present application. Cancellation of claims 5-7, 12-14, 18-20, and 25-27 removes Songting Chen's contribution to the present application; thus, Songting Chen is not a joint inventor of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of the present application (See Exhibit A). Applicants are filing a correction of inventorship herewith to delete Songting Chen as an inventor of the present application (See Exhibit B).

Secondly, page 12 paragraph 1 of Applicants' Amendment filed on June 27, 2006 requested to "[p]lease charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441." Therefore, Applicants have complied with the two requirements to for amendment of inventorship as set forth in MPEP 201.03 (III).

In addition, Office Action argues that the 1.132 Declaration is ineffective (Office Action, p. 2, para. 3). In support for this argument, the Office Action asserts that Applicants have not provided evidence that establishes that the subject matter relied on in the reference was derived from the applicant and invented by the applicant (Office Action, p. 2, para. 3). The Office Action also asserts that the Declaration does not "assert invention and facts establishing derivation" (Office Action, p. 2, para. 3).

Applicants disagree with such a conclusion, and submit that the Declaration under 37 CFR 1.132 (also referred to herein as the "Declaration"), which was filed on 6/27/2006 and signed by all of the original inventors of the present application, provides evidence that the cited prior art reference (i.e., Palpanas et al., NPL "Incremental Maintenance for Non-Distributive Aggregate Functions", Proceedings of the 28th VLDB Conference, Hong Kong, China, 2002 (also referred to herein as "Palpanas et al.)) was derived and invented by all of the currently claimed inventors of the present application (i.e., Richard Sidle, Roberta Cochrane, Hamid Pirahesh). Additionally, the Declaration asserts invention of the subject matter relied on in Palpanas et al. and facts establishing derivation of the claimed invention from Palpanas et al. MPEP 716.10 provides that:

an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable ... Where there is a published article identifying the authorship ... that discloses subject matter

being claimed in an application undergoing examination, the designation of authorship ... does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f). However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application). An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship ... However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary.

(emphasis added). Applicants note that the Office Action does not present any evidence to contradict Applicants' inventorship in view of Palpanas et al.

Page 1 paragraph 2 of the Declaration states that "Richard Sidle, Roberta Cochrane, Hamid Pirahesh, and Themistoklis Palpanas are co-authors of the following paper: Palpanas et al., NPL "Incremental Maintenance for Non-Distributive Aggregate Functions", Proceedings of the 28th VLDB Conference, Hong Kong, China, 2002."

Moreover, page 2 paragraphs 1-2 of the Declaration states that "Incremental Maintenance for Non-Distributive Aggregate Functions' discusses aspects of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial

No. 10/643,644, filed on August 19, 2003. Richard Sidle, Roberta Cochrane, and Hamid Pirahesh are joint inventors of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644." Therefore, in satisfaction of MPEP 716.10, the affidavit under 37 CFR 1.132 shows "that the reference discloses subject matter derived from the applicant".

Furthermore, page 3 paragraph 2 of the Declaration states that "Richard Sidle, Roberta Cochrane and Hamid Pirahesh are the *only* joint inventors of the invention defined by claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644. Further, because Richard Sidle, Roberta Cochrane, and Hamid Pirahesh are also co-authors of 'Incremental Maintenance for Non-Distributive Aggregate Functions', 'Incremental Maintenance for Non-Distributive Aggregate Functions' describes Applicants' own work and should therefore be removed as a reference against claims 1-4, 8-11, 15-17, and 21-24 of U.S. Patent Application Serial No. 10/643,644" (emphasis in original). Therefore, in satisfaction of MPEP 716.10, the declaration "attribute[s] an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable".

Therefore, contrary to the position taken in the Office Action, the Declaration under 37 CFR 1.132, which was filed on 6/27/2006 and signed by all of the inventors of the present application, provides evidence that establishes that the subject matter relied on in Palpanas et al. was derived from and invented by Applicants. Additionally, the Declaration asserts invention of the subject matter relied on in Palpanas et al. and facts establishing derivation of the claimed invention from Palpanas et al.

In addition, the Office Action argues that “[i]t is not clear what contributions Themistoklis Palpanas provided to the article, particularly since he did not contribute to the invention. Therefore the reference still qualifies as prior art under 102 (a)” (Office Action, p.2, para. 4).

Applicants are not required to expressly define what contributions Themistoklis Palpanas made to the cited reference. The Office Action does not cite any legal authority setting forth this asserted requirement. All that MPEP 201.03 and 37 CFR 1.48(b) requires is that Applicants attribute the cited reference as Applicants’ own work.

In view of the foregoing, Applicants submit that the inventors of the claimed invention are co-authors of the cited reference; and therefore, the cited reference describes Applicants’ own work. Moreover, Applicants have provided evidence to support such assertions in the Declaration. Accordingly, Palpanas et al. should be removed as a reference against the claimed invention.

II. Formal Matters and Conclusion

In view of the foregoing, Applicants submit that claims 1-4, 8-11, 15-17, and 21-24, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any


10/643,644

13

deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

Dated: 11/27/06



Duane N. Moore
Registration No. 53,352

Gibb I.P. Law Firm, LLC
2568-A Riva Road, Suite 304
Annapolis, MD 21401
Voice: (410) 573-6501
Fax: (301) 261-8825
Customer Number: 29154